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Subject: U.S. Trademark Application Serial No. 88981832 - BOYS WORLD - LNA-US-00238 - Examiner Brief
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Attachments

United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 88981832

Mark: BOYS WORLD

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Reference/Docket No. LNA-US-00238

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EXAMINING ATTORNEY'S APPEAL BRIEF

I. INTRODUCTION

The application for registration in this case is for the mark BOYS WORLD in use in commerce with "audio recordings featuring music." The applicant has appealed the trademark examining attorney's refusal to register the applied for mark on the Principal Register under Sections 1, 2, and 45 of the Lanham Act for failing to function as a mark owing to the mark being the name of a recording artist. The examining attorney respectfully asks that the refusal to register the mark be affirmed.

II. STATEMENT OF FACTS

The application was filed, under Section 1(b), on June 24, 2019. The case was approved for publication soon after on July 22, 2019. In between the Notice of Allowance and the filing of the Statement of Use the applicant filed a Request to Divide the goods in Class 9 on April 29, 2021. This division left only "audio recordings featuring music" in this application. Also on April 29, 2021, applicant filed their Statement of Use. A non-final Office Action was issued on June 4, 2021 refusing the mark because it failed to function as a trademark as the mark was the name of a musical artist and would only be seen as such by the consuming public. Applicant responded with specimens, evidence, and arguments on October 23, 2021. The examining attorney finally refused the application on October 29, 2021. Applicant filed a Request of Reconsideration on April 26, 2022 with additional evidence and arguments. Applicant concurrently filed this appeal. The Request for Reconsideration was denied on July 6, 2022.

III. ISSUE ON APPEAL

The sole issue on appeal is whether the applied-for mark as applied to the specimen of record functions as a source indicator or merely identifies the name of a featured performer on a sound recording.

IV. OBJECTIONS

Applicant has submitted new evidence with its appeal brief. Specifically, applicant provided a list of third-party registrations to demonstrate the Office's past treatment of similar marks. The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because applicant's new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. *See In re tapio GmbH*, 2020 USPQ2d 11387, at *3-4 (TTAB 2020); *In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at *2 (TTAB 2020); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

Arguments proffered in connection with the untimely evidence should also be rejected as the arguments both lack an evidentiary basis and that the Board is not bound by the findings of examiners in other cases. "There can be no doubt that 'the Board . . . must assess each mark on the record of public perception submitted with the application.' Thus, the mere fact that applicant has submitted [third party registrations] . . . cannot change our mandate to review the registrability of the involved mark on the

record created during the prosecution of the involved application." *In re First Draft*, 76 USPQ2d at 1187 (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). The Board routinely notes that its decisions are not bound by examiner's determinations as to the registrability of marks in other applications and neither should the Board be bound here.

V. LEGAL STANDARDS

Any mark consisting of the name of an author used on a written work, or the name of a performing artist on a sound recording, must be refused registration under §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, if the mark is used solely to identify the writer or the artist. *See In re Polar Music Int'l AB*, 714 F.2d 1567, 1572, 221 USPQ 315, 318 (Fed. Cir. 1983); *In re Arnold*, 105 USPQ2d 1953, 1957-60 (TTAB 2013); *In re First Draft, Inc.* 76 USPQ2d 1183, 1190 (TTAB 2005); *In re Peter Spirer*, 225 USPQ 693, 695 (TTAB 1985). A mark of this type can be registered - and therefore not solely identifying the artist - if two elements are satisfied:

1. it is used on a series of recorded works, and
2. the application contains sufficient evidence that the name identifies the source of the series and not merely the performing artist.

See In re Arnold, 105 USPQ2d at 1958.

The use of the author's or performer's name on a series of works does not, in itself, establish that the name functions as a mark. The record must also show that the name serves as more than a designation of the writer or performer, i.e., that it also serves to identify the source of the series. *See In re Arnold*, 105 USPQ2d 1953, 1959-60 (TTAB 2013) (holding BLATANCY fails to function as a mark because it merely identifies the name of a performer featured on applicant's musical recordings, and finding the evidence relating to control over the mark and the nature and quality of the goods conflicting and of uncertain meaning); *In re First Draft*, 76 USPQ2d 1183, 1191 (TTAB 2005) (holding pseudonym FERN MICHAELS identifies only the author and does not function as a mark to identify and distinguish a series of fictional books because the "evidence of promotion" was "indirect and rather scant," despite applicant's showing that the name had been used as an author's name for 30 years; that 67 separate books had been published under the name, and approximately 60 million copies had been sold; that the book jackets listed the titles of other works by Fern Michaels and promoted her as a

bestselling author; that the author had been inducted into the New Jersey Literary Hall of Fame; and that there was a www.fernmichaels.com website); *In re Chicago Reader Inc.*, 12 USPQ2d 1079, 1080 (TTAB 1989) (holding CECIL ADAMS, used on the specimen as a byline and as part of the author's address appearing at the end of a column, merely identifies the author and does not function as a trademark for a newspaper column).

A showing that the name functions as a source identifier may be made by submitting evidence of either: (1) promotion and recognition of the name as a source indicator for the series); or (2) the author's or performer's control over the name and quality of his or her works in the series. *See In re Arnold*, 105 USPQ2d at 1958.

VI. ARGUMENTS

As an initial matter, the first element noted above, the evidence of a series, has been met in this case and is not at issue. Further, applicant has chosen not to proffer any statement under oath that the performer controls the name and quality of the work in the series thus foreclosing a finding of as to source indication based on a sworn statement only. Thus, the only issue remaining is whether the applicant met their burden of proof by providing sufficient evidence of promotion and recognition such that the performing artist's name in the mark would be perceived by consumers as identifying the source of the series and not merely the performing artist. The applicant has not made this showing and thus the mark does not function as a source indicator.

A. THE MAGIC SCHOOL BUS & FERN MICHAELS

Promotion and recognition evidence factor heavily into two cases previously before the Board, *In re Scholastic, Inc.*, 23 USPQ2d 1774 (TTAB 1992), regarding the book series *The Magic School Bus*, and *In re First Draft*, 76 USPQ2d 1183 (TTAB 2005) on the use of author Fern Michaels' name on her books.

In *Scholastic* the Board found that based on substantive evidence that *The Magic School Bus* was seen by consumers as more than just part of a title for books. The record included "several reviews of books . . . which appeared in such widely circulated publications as The New York Times, The Washington Post, and The Los Angeles Times, and in trade publications such as Publishers' Weekly and School Library Journal, the reviewers consistently refer to the series of children's books as

'the Magic School Bus books,' 'the Magic School Bus series' or 'the series of Magic School Bus books.'" *In re Scholastic.*, 23 USPQ2d at 1777. Also included were promotional materials "distributed by applicant which feature the designation THE MAGIC SCHOOL BUS per se, apart for any book title." *Id.* Apart from the applicant's promotional evidence there was substantial evidence of recognition by consumers including - made under a declaration - letters from book store owners, public school administrations, as well as the merchandise manager at a large book store chain that parents and children specifically ask for the Magic School Bus series or Magic School Bus books, and not just individual titles. *Id.* at 1778. Finally, applicant noted that over one million copies of the books had been sold and over \$100,000 was spent in promotional efforts. *Id.* at 1776.

The evidence of promotion and recognition in the *First Draft* case consisted of "67 romance novels, [author] over 60 million books [sold] in the United States and throughout the world, and [author was] inducted into the New Jersey Literary Hall of Fame." *In re First Draft*, 76 USPQ2d at 1185. The Board specifically noted that this evidence was "indirect and rather scant" going further to note that the evidence did not have any "reviews showing the manner in which others use the designation FERN MICHAELS. Nor do we have promotional materials touting FERN MICHAELS novels," "information whatsoever regarding advertising or promotional expenditures," or "declarations from publishers, retailers, purchasers, or readers." *Id.* at 1191.

The Board in these two cases clearly highlights evidence that is helpful in proving that a performing artist's name functions as a source identifier. Such evidence takes the form of: 1) third-party industry usage that specifically shows the name being used as a source designation, 2) direct, third-party evidence of recognition of by consumers of the name as a source identifier, 3) information regarding advertising and promotion expenditures by the applicant and 4) promotional materials wherein the applicant themselves markets the name as a source identifier.

B. APPLICANT'S EVIDENCE DOES NOT REACH THE LEVEL OF THE MAGIC SCHOOL BUS

i. ARTICLES

The majority of applicant's evidence of promotion and recognition of its name as a source identifier consists of articles written about them as recording artists. Applicant highlights at least twenty of these

articles in their bulleted list. Applicant's Brief, at 5-7. This evidence is insufficient because the articles are missing important context with regards to circulation and readership, there is little highlighting of the use of the term as a brand and there is little if any demonstrable evidence of recognition of the name as a source identifier by either consumers or the media and/or music industry.

With regards to circulation and readership context, *In re Scholastic* notes that the articles used to show promotion and recognition of the term were from world renowned newspapers with millions of readers as well as large trade publications. In this case, we have no information about the websites from which the articles were gleaned, e.g., how many times they've been visited and accessed, their reach in terms of the media ecosystem, etc. Moreover, and more importantly, there is little indication that these publications are referring to the applied for mark in a manner that would help it garner the recognition needed to overcome the failure to function refusal. Throughout the articles the use of the term is to denote the performing artist and not that of the source of the goods.

Another factor to be considered at this point is the amount of money spent on promotion. While not always indicative of recognition this evidence can circumstantially show attempts by applicant to educate consumers with regards to source identification. In *Scholastic* over \$100,000 was spent back in the late 1980s and early 1990s on promotion, the Board found this to be helpful evidence in finding for the mark acting as source identification. The lack of such information was specifically noted in *First Draft* as one of the reasons the Board found the name Fern Michaels didn't function as a mark. This case, with regards to expenditures is much more like *First Draft* than *Scholastic* as there is no evidence as to the promotional and/or advertising expenditures of the applicant in order to reach consumers and educate them that the band in this case was also a brand.

While not directly addressed in either *Scholastic* or *First Draft* the articles submitted as evidence also highlights an impediment to applicant showing source identification, namely, the relatively new use of the mark in commerce. The evidence in this case clearly shows the band is so new to the music scene that they have had little time to establish themselves as a band, much less a brand. To begin the applicant has merely being using the mark for just over two years. Furthermore, the articles make it clear just how new the band is. for example, *People Magazine* notes "on Friday, the girl group released their debut EP While You Were Out" and Unpolishedzine.com wrote "the girls released 'Wingman' as their second official single. . . ." April 26, 2022 Request for Reconsideration,

TSDR at 60, 46. These quotations are emblematic of how new this band is, they've just put out a debut EP, before that it was just two singles under their name, there isn't even an entire album yet. While being new to the marketplace in no way disqualifies the applicant from proving source identification, with so little time in terms of use in commerce the group there is not much evidence that applicant has proved used of the mark in a series, much less consumer recognition of the artists' name as a source identifier.

Thus, the submitted evidence, while voluminous, misses the mark in this case as it at best shows attempts at promotion of the band as a brand but provides no substantive evidence of the necessary recognition of the term as a mark by consumers. There is no context to the reach, readership, or effect of the submitted articles. The articles themselves, unlike in *Scholastic*, don't consistently show people asking for, or the press referring to BOYS WORLD albums and the like. Further, there is no indication as to how much was spent to promote the applicant as a brand. Therefore, the evidence of record does not show the type of promotion or recognition required to show that consumers see the term as the source of the recordings.

ii. SOCIAL MEDIA AND MESSAGE BOARDS

Applicant's evidence also consists of social media pages for the band. Applicant recounts statistics such as the #boysworld trend on YouTube had over 350 videos, that the band's YouTube Channel has 154,000 subscribers, the Spotify page has over 250,000 monthly listeners, etc. Applicant's brief, at 5; 2022 Request for Reconsideration, TSDR at 12-16. Presenting raw numbers, without contextual evidence, does not prove that the mark is seen as a source identifier. In *First Draft* the author Fern Michaels had written 67 books, sold 60 million copies and was in the New Jersey Literary Hall of Fame. *In Re First Draft*, 76 USPQ2d at 1185. Ms. Michael's evidence did not show that consumers recognized the name of the author as a mark; the evidence certainly showed the author was prolific, popular, and had a distinguished literary career, but did not show recognition as a source identifier. Applicant's social media numbers tell a similar story, that of an up-and-coming musical act, but not a brand. Applicant proffers arguments that these numbers somehow show recognition, for instance, with regards to the YouTube subscriber numbers "154,000+ subscribers who have come to recognize Applicant's Mark as an identifier of source for all of [sic] recordings contained therein." Applicant's Brief, as 5. The same is true for applicant's contention that "[the Spotify evidence] showing more than

250,000 monthly listeners who recognize Applicant's Mark as the source of the series of recordings contained therein." *Id.* There is no explanation as to how these numbers from YouTube and Spotify shows a consumer recognition that the name of the musical artist is also the source of quality of the sound recording and not just the voices on the recording itself. Applicant's arguments that their social media numbers prove consumer recognition are without merit as the evidence here are akin to the evidence in *First Draft*, undoubtedly showing a degree of popularity with the public, but not showing that the public see the term as a source identifier.

In terms of direct, consumer recognition of the mark as a source identifier the applicant has proffered three total pages of message board postings. 2022 Request for Reconsideration, TSDR at 116, 123. This evidence is a far cry from the evidence presented in *Scholastic* with regards to declarations made by numerous, reliable sources testifying as to the source identification of *The Magic School Bus*. Thus, evidence going directly to the heart of the issue in this case is scant at best and the posts themselves don't necessarily show consumers seeing the mark as a source identifier but merely discussing the band as fans of the group.

C. APPLICANT'S EVIDENCE DOES NOT SHOW UNAMBIGUOUS CONTROL OF THE MARK

Another case dealing with this particular type of refusal is *In re Arnold*, 105 USPQ2d 1953 (TTAB 2013). One of the tenets of this case, and the showing that must be made by applicants in cases like these, is "the Board has required unambiguous evidence of an applicant's control over the mark and the goods, as well as evidence to show that the mark functions as a source indicator." *Id.* at 1959. In *Arnold* there was a mixed bag of evidence not all pointing to one party controlling the mark and such ambiguity was detrimental to the showing of recognition as a source, "evidence by applicant give[s] rise to substantial ambiguity as to control over the mark and the goods. It was applicant's burden to dispel such ambiguities by means of reliable fact-based evidence, such as affidavits or business records, and to thereby address the central question of control over the mark and the goods." *Id.* at 1960.

In the case at hand there is quite the ambiguity as to who controls the mark and the goods — BOYS WORLD or KYN Entertainment. In at least two of the specimens of record and in the evidence

applicant submitted to show the term as part of a series there is a copyright notice - one in 2020 and one in 2021- that is for KYN Entertainment. August 23, 2021 Response to Office Action, TSDR at 9, 12; April 26, 2022 Request for Reconsideration, TSDR at 139, 142, 148. The name of this record label is also littered throughout the articles submitted as evidence; it seems to be one of the things highlighted by many journalists when discussing how the group was formed:

- ". . . before being founded by KYN entertainment – on April 26th, 2019, to be exact – the girls posted covers on social media and YouTube to garner attention over social media . . ." April 26, 2022 Request for Reconsideration, TSDR at 45,
- ". . . that all changed when, one by one, the girls got a DM from KYN entertainment executives. . ." April 26, 2022 Request for Reconsideration, TSDR at 49,
- "The group was formed by KYN Entertainment after the company directors contacted each of the members on social media, having seen their singing videos online . . ." April 26, 2022 Request for Reconsideration, TSDR at 52 ,
- "Boys World were individually scouted throughout 2018 on Instagram by KYN Entertainment . . ." April 26, 2022 Request for Reconsideration, TSDR at 56 ,
- ". . . in 2019, KYN Entertainment was on the hunt to find singers to be a part of a girl group and individually found each of the members on Instagram . . ." April 26, 2022 Request for Reconsideration, TSDR at 71,
- ". . . formed in Los Angeles record company KYN Entertainment in 2019" April 26, 2022 Request for Reconsideration, TSDR at 80,
- ". . . formed in 2019 by KYN Entertainment after members were individually scouted through Instagram . . ." April 26, 2022 Request for Reconsideration, TSDR at 83 ,
- ". . . the girl group first came to life in April 2019 when record label KYN Entertainment reached out to each of them on Instagram to compliment their song covers and offer them a spot in the band. . ." April 26, 2022 Request for Reconsideration, TSDR at 88 ,
- "They formed after KYN Entertainment scouted each of them individually on Instagram," April 26, 2022 Request for Reconsideration, TSDR at 94.

Like in *Arnold* there is a substantial question here as to control of the mark stemming from the broad use of the record label's name in this case both in articles about the musical group as well as on

copyright notices on the works themselves. Because the evidence is not clearly and unambiguously pointing at the musical artists as the source identifier the evidence in this case the outcome should mirror that in *In re Arnold* where in the name of the musical artist was not found to be a source identifier.

VII. CONCLUSION

For the foregoing reasons, the applicant has failed to meet their burden in this case and thus the refusal to register under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051, 1052, and 1127 for the mark failing to function as a mark should be affirmed.

Respectfully submitted,

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USPTO OFFICIAL NOTICE

Examining attorney's appeal brief has issued
on November 10, 2022 for
U.S. Trademark Application Serial No. 88981832

A USPTO examining attorney has issued an appeal brief. Follow the steps below.

- (1) **[Read the appeal brief](#)**. This email is NOT the appeal brief.
- (2) **Submit reply brief within 20 days of November 10, 2022**, if you wish to do so. If submitted, a reply brief must be submitted using the **[Electronic System for Trademark Trials and Appeals \(ESTTA\)](#)** and received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the reply period.
- (3) **Direct questions** about the appeal proceeding to the Trademark Trial and Appeal Board at 571-272-8500 or **TTABInfo@uspto.gov**.